

REMARKS

Claim 70 is rejected under 35 U.S.C. § 103 as being unpatentable over Moody (US 6,098,985) in view of Carrico (US 6,416,407). Claim 71 is rejected under 35 U.S.C. § 103 as being unpatentable over Moody (US 6,098,985).

Page 4 of the rejection rejects claim 71 and states:

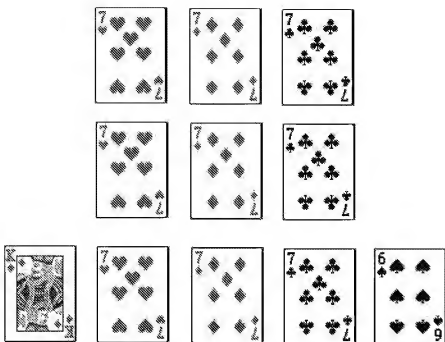
Regarding claim 71: Moody discloses a method to play a wagering game, the method comprising an electronic gaming machine, receiving a wager from a player, (abstract, line 2); dealing a first initial hand of 5 cards face up (abstract lines 5); selecting, by a player, first hand hold card(s) from the first initial hand, (abstract lines 67); forming a second initial hand using the first hand hold card(s), the second initial hand being in a different row than the first hand, (abstract lines 7-8); forming a third initial hand using the first hand hold card(s), the third initial hand being in a different row than the second hand, (abstract lines 7-8 and fig. 2); replacing all card(s) in the first initial hand which are not first hand hold card(s) with newly dealt face up card(s) to form a first intermediate hand, the first intermediate hand being in a same row as the first initial hand, dealing new card(s) face up in the second initial hand to form a second intermediate hand with 5 cards, the second intermediate hand being in a same row as the second initial hand, dealing new card(s) face up in the third initial hand to form a third intermediate hand with 5 cards, the third intermediate hand being in a same row as the third initial hand, (abstract lines 9-14 and figs. 3-5); evaluating ranks of the multiple first final hands and paying any respective awards to the player, (col. 3:37-41). Moody is silent on repeating the step of selecting cards and forming another set of three hands as done by the first selecting of claim 71, and in such the selecting, by a player, first intermediate hand hold card(s) from the first intermediate hand and generating multiple first final hands, each first final hand formed using the first intermediate hand hold card(s) and newly dealt face up card(s), each of the multiple first final hands being dealt in a separate row, selecting, by a player, second intermediate hand hold card(s) from the second intermediate hand and generating multiple second final hands, each second final hand formed using the second intermediate hand hold card(s) and newly dealt face up card(s), each of the multiple second final hands being dealt in a separate row, and selecting, by a player, third intermediate hand hold card(s) from the third intermediate hand and generating multiple third final hands, each third final hand formed using the third intermediate hand

hold card(s) and newly dealt face up card(s), each of the multiple third final hands being dealt in a separate row, would be considered a mere duplication of parts and has no patentable significance unless a new and unexpected result is produced, (MPEP Chapter 2144.04 [R-6] VI), the result in this case is the generation of three more hands per already generated three hands with a total of nine hands, and if done again would yield 27 hands. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to replicate the original steps of Moody and yielding the predictable result of generating nine more playing hands.

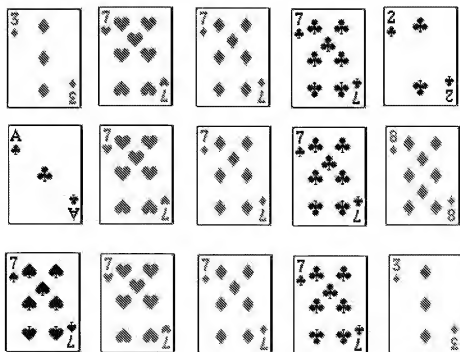
With regard to the rejection of claim 71, the gist of the rejection is that claim 71 is “a mere duplication of parts,” namely the Moody application duplicated. The Applicant will show that this is not a true and accurate characterization of the invention recited in claim 71. Consider the features in Moody are denoted by function f , wherein i =input and $f(i)$ is the output with input i . In Moody, the input is a five card poker hand (the player's starting hand) with respective wager and the output of the function $f(i)$ is three final hands (assuming the “triple play” version of Moody is being implemented) with a payout on each of the final hands.

If claim 71 were simply a mere duplication of parts, then a mere duplication of moody would be $f(f(i))$, in other words, performing the Moody function and then using the results as a starting point to perform Moody a second time. In order to remove any nondeterministic element to this example, the player can be assumed to play optimal strategy (although of course this is not generally required). Therefore, to perform $f(f(i))$, then the following sequence would take place:

Consider that a player is first dealt (i) King-diamonds, 7-hearts, 7-diamonds, 7-clubs, 6-spades. The player then decides to hold the three sevens, which are then copied to the higher hands as follows:



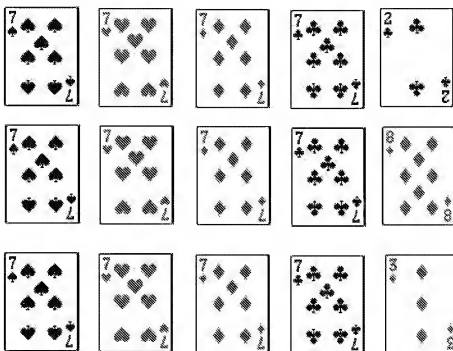
The player now draws, which replaces the discarded cards (all the cards that are not sevens) with random newly dealt cards as follows:



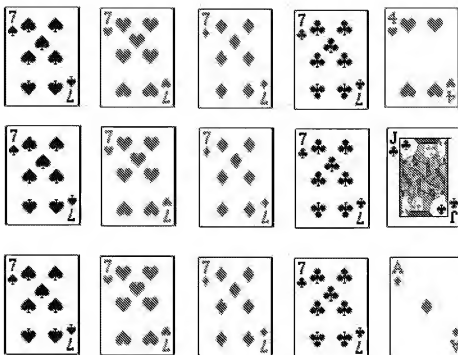
The player is paid according to the ranks of the hands. This is essentially

the Moody invention.

Now in this example we are performing what would be considered a “mere duplication” of Moody. So now we are going to apply Moody again, and use the previous output (shown above) as the input to the function. First we note that the output of the function (three hands) and the input (one starting hand) are not identical so already this shows that the combination is not a mere duplication, but for purposes of this example we will use the bottom hand of the previous output as the single hand input. So now the player makes another wager and would have the opportunity to hold the four sevens in the bottom hand which are copied to the higher hands as follows:



Then the player draws and replaces the non-held sevens with randomly dealt new cards such as follows:



Now the player has three hands of four sevens each and is paid on all three hands and the game is over.

The above example is what happens when $f(\text{Moody})$ is merely duplicated twice, or $f(f(i))$. The player ends up with three final hands. If Moody was performed in triplicate $f(f(f(i)))$, then the player would still end up with three final hands (but would make three wagers and get paid three times).

In contrast, the invention recited in claim 71 (in the embodiment wherein “multiple final hands” are three hands) results in nine final hands all displayed simultaneously. Additionally, while the $f(f(i))$ operations allows the player to make two decisions, the invention as recited in claim 71 allows the player to make four decisions. Therefore, it is clear from the above example, that claim 71 cannot be mere repetition or duplication.

Therefore, MPEP 2144.04 [R-6] VI(b) regarding “duplication” does not apply. If the Examiner still considers the pending claims to be a mere duplication, then he is using impermissible hindsight after reading the specification to characterize this as a

“duplication” because a straight duplication was exemplified above. It is also difficult to apply canons applicable to apparatus claims to method claims of the kind recited herein.

Nevertheless, the Examiner may contend that while claim 71 is not the simple duplication as explained in the example above, certain parts of Moody are still being duplicated in claim 71 to render the claim obvious. However, the Applicant submits that claim 71 can, if anything falling under MPEP 2144.04, be considered more of a ‘rearrangement of parts’ than a ‘duplication’ since different features of Moody have to be rearranged, reorganized, and omitted, in order to create claim 71.

MPEP 2144.04 VI(c) applies to a ‘rearrangement of parts’ and states: The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.” Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

The rejection states, “It would have been obvious to one of ordinary skill in the art at the time of applicant’s invention to replicate the original steps of Moody and yielding the predictable result of generating nine more playing hands.” However, generating n additional hands (wherein n can be any constant) can be simply achieved in Moody by copying the bottom hand n times and then carrying out the Moody method (e.g., instead of “triple play” there can be “nine-play”). However, the rejection has not identified a motivation or reason to make the necessary changes in the prior art to **create the configuration as claimed in claim 71**. It might be logical for the Examiner, **after reading the Applicant’s specification**, to conclude that it is obvious for an inventor to rearrange Moody in order to create claim 71, however, the Applicant submits that this is the product of impermissible hindsight.

Therefore, the Applicant submits that claim 71 is not taught or suggested by Moody. Once again, a simple duplication might result in the example illustrated above, not the invention recited in claim 71.

The Office Action also rejects claim 70 under 35 U.S.C. § 103 as being unpatentable over Moody in view of Carrico.

The Applicant wishes to present an example of what a combination of Moody and Carrico might perhaps be. The player is first dealt (after making an initial wager) is first dealt (i) King-diamonds, 7-hearts, 7-diamonds, 7-clubs, 6-spades. Then according to Carrico, the player has a chance to select discards and draw. Assuming the player wishes to hold the three 7's, the player draws and now has a hand of: 3-hearts, 7-hearts, 7-diamonds, 7-clubs, ace-spades. The player is now paid for three of a kind. The player chooses to draw again and makes a second wager and the player again holds the three 7's and draws to: 7-spades, 7-hearts, 7-diamonds, 7-clubs, 9-hearts. The player is now paid for 4 of a kind. Now it is time to attach Moody and the final output of 7-spades, 7-hearts, 7-diamonds, 7-clubs, and 9-hearts is now fed into Moody. The player then chooses to hold all four sevens, which are copied in the above hands, and the player draws a single card on each hand (which is irrelevant) and results in three hands of four of a kind on all levels.

Once again, this aggregation of Moody and Carrico is a different configuration from either claim 70 or claim 71. The final result is still three final hands while the player was not afforded a chance to draw on the individual intermediate hands. Nothing in these two references teaches or suggests combining them in such a way which results in the rearrangement of features in claims 70 and 71. One advantage of the configuration recited in claims 70 and 71 is that a player may feel more in control by having the ability to decide and play the individual hands. Furthermore, the structure as recited in claims 70-71 could be subject to different mathematical variances than the straight combination of Moody and Carrico described above.

Furthermore, assuming that Moody and Carrico can be combined, there would be nothing in either reference to suggest combining them in the configuration as recited in the claim. Once again, please see the discussion and figures above regarding the duplication of features in Moody which shows how the claims are not a mere aggregation or duplication of the applied references.

The closest thing to a combination of Moody and Carrico was previous claim 68 (although not a strict combination), which was canceled in order for the Applicant to focus on the claims which are clearly not a simple combination or duplication of features in the applied references.

In any event, the claims are amended to recite that the intermediate hands do not trigger a payout and that the second round of selecting occurs without receiving an additional wager. Carrico teaches away from these features. For example, Carrico, column 5, lines 43 states, “If the player at 50 chooses not to stand pat as described above, the player indicates At this point, in order to continue play, the player must make an additional wager at 66.” Thus, Carrico describes a system which requires additional wagers. Carrico also pays a first payout and a second payout at different hands in the game (see Carrico, column 6, lines 30-60, and Figure 1).

Therefore, in view of the discussion above and the amendments to the claims, it is clear that the pending claims are not a mere duplication of parts of Moody and/or Carrico. Furthermore, the Applicant submits that there is nothing in the references to suggest configuration a game as recited in claims 70-71. While the Examiner may submit that the features in claims 70-71 may be considered a “rearrangement” of parts in Moody and/or Carrico, the Applicant submits that most patent in the gaming field (or any patents for that matter) are combinations of prior art features, and that nothing in the applied references or the prior art itself suggests creating a multi-line game that is configured exactly as recited in claims 70-71.

MPEP 2142 states, “The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” The applicant submits that a mere conclusory statement (“generating a predictable result”) is not adequate since such any result can be generated using numerous different configurations (e.g., playing Moody’s original game with 9 lines to result in 9 hands), however the rejection must articulate **why** the exact configuration recited in the claims would have been obvious to arrive at **without** benefit of the Applicant’s specification.

Therefore, in view of all of the above, the Applicant submits that claims 70-71 (as amended) are not taught or suggested by the applied references, and withdrawal of the rejections is respectfully requested.

Respectfully submitted,

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